

REMARKS

Claims 17-30¹ are pending in the application, with claims 17-22 being withdrawn from consideration, in the Office Action dated October 15, 2003, as drawn to a non-elected invention. In the Final Office Action, the Examiner rejected claims 23-30 under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 4,611,181 to Fukumura et al. ("Fukumura") in view of Japanese Pub. No. 08265044 A to Taketoshi et al. ("Taketoshi") and Japanese Pub. No. 04236517 A to Masa ("Masa").

Applicants respectfully traverse the §103(a) rejection of claims 23-30 to Fukumura in view of Taketoshi and Masa because the Examiner failed to establish a *prima facie* case of obviousness under §103(a). In order to maintain a valid §103(a) rejection, each of three requirements must be met. First, the reference or references, taken alone or combined, must teach or suggest each and every element recited in the claims. (See M.P.E.P. §2143.03 (8th ed. 2001).) Second, there must be some suggestion or motivation, either in the reference(s) themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must "be found in the prior art, not in Applicant's disclosure." (M.P.E.P. § 2143 (8th ed. 2001).)

1. Applicants note that the Office Action Summary only indicates claims 23-30 are pending in the application. Because claims 17-22 have been withdrawn from consideration (as correctly indicated on page 2 of the Office Action), and have not been cancelled by Applicants, they are officially still pending in the application.

Regarding the rejection of claims 23, 25, and 27, Fukumura merely teaches a temperature-compensated oscillation device which reduces the frequency variations and the noise over a temperature range (col. 5, lines 5-8). Specifically, Fukumura discloses a temperature sensor (11) which produces an analog temperature data signal at line (101) (col. 3, lines 52-54; Fig. 5). This analog signal is quantized into a digital temperature value by A/D Converter (12) and is sent over data bus (102) to be applied to the address input terminal of ROM (21) (col. 3, lines 55-58; Fig. 5). ROM (21) produces another digital value from a particular address which was specified by the digital temperature value (col. 3, lines 58-60). The digital value produced by ROM (21) is sent over data bus (201) to comparator (22), which, along with Up/Down Counter (23), generates a digital output which reduces the stepwise frequency variations in the digital value produced by ROM (21). (See col. 4, lines 50-53; Fig. 6). The digital output produced by Up/Down Converter (23) is sent over data bus (205), converted to analog by D/A Converter 31, and the resulting analog voltage is applied to Voltage Controlled Oscillator (VCO) (31) to compensate temperature-induced frequency variations (col. 4, lines 22-30; Fig. 5). The Examiner asserts Fukumura teaches “first/second storage means . . . [and] correction processing means for selectively reading, from the first storage means, a corrected temperature” (See Office Action, page 2, lines 20-23.) Applicants disagree with the Examiner’s interpretation of Fukumura, and respectfully submit that, in contrast, Fukumura teaches storing values associated with frequency in ROM 21 since these values are applied to VCO (32) through D/A Converter (31). Fukumura merely teaches that values associated with temperature are only used to address the data stored in ROM 21. (See hereinabove, and col. 3, line 57.) Moreover,

the Examiner further asserts that Fukumura teaches “operation data stored in the second storing means (figure 5, #2, control section)” (See Office Action, page 2, lines 25-26.) Applicants submit that Fukumura only teaches storing data associated with frequency corrections in ROM (21) which is subsequently applied to VCO (32).

Conversely, Fukumura fails to teach or suggest, at least “correction processing means for selectively reading, from the first storage means, a corrected temperature corresponding to the ambient temperature detected by the temperature detecting means, and for correcting the operation of electronic circuit on the basis of the corrected temperature and the operation correction data stored in the second storing means” as recited in claims 23, 25, and 27. (emphasis added.)

In addition, Taketoshi and Masa fail cure the noted deficiencies of Fukumura in this respect. Taketoshi merely teaches the use of temperature sensor 8 which senses a temperature of a crystal vibrator 1a. Furthermore, Taketoshi teaches an EEPROM 9 storing plural kinds of transmission signal patterns and also stores offset data quantizing a temperature characteristic curve of the crystal vibrator 1a over a prescribed temperature range. (See Abstract: Constitution).

Masa merely teaches storing offset address data in a memory 3A to compensate for dispersion in a temperature detector. The offset address data is latched in a latch circuit 6 at starting, the offset address data and an address data resulting from converting an output of the temperature detector are added by an adder. (See Abstract.)

In summary, Fukumura, Taketoshi, or Masa, taken either separately or in any combination, fail to teach or suggest all of the elements recited in claims 23, 25, and 27.

Additionally, there is no motivation to modify the teachings of Fukumura by the teachings of Taketoshi or Masa. Fukumura directly addresses the contents of ROM (21) using digital temperature data (col. 3, line 57), and would not require, or be capable of, utilizing stored offset data as taught by Taketoshi (Abstract: Constitution, lines 10-13) or Masa (Abstract: Constitution: lines 1-3). Moreover, the Examiner asserts that the motivation for modifying Fukumura would be to “perform quick look ups and corrections for quick and accurate results” (See Office Action, page 3, lines 17-18.) Applicants submit this motivation is unfounded, since the direct access taught by Fukumura is most efficient, and would only be slowed down by additional memory accesses for obtaining offset temperature data, as taught by Taketoshi or Masa.

Accordingly, Applicants respectfully request the Examiner to withdraw the rejection of claims 23, 25, and 27. Claims 24, 26, and 28 depend from claims 23, 25, and 27, respectively, and are allowable for at least the reasons provided above for allowable claims 23, 25, and 27 by virtue of their respective dependencies. Claim 29, while of different scope, includes recitations similar to claim 23, and is allowable at least for the same reasons as allowable claim 23. Claim 30 depends from claim 29, and is allowable for at least the reasons provided for allowable claim 29.

Regarding claims 25 and 29, Applicants submit that the Examiner inappropriately introduced a new reference, JP 09307355 to Osamu et al. (“Osamu”), which is not included as the basis for the original §103(a) rejection of these claims. In other words, the Examiner set forth an alternative rejection and did not explicitly provide a statutory basis associated with Osamu for the rejection of claims 25 and 29. However, Applicants infer from the Office Action that these claims may have also been rejected

under 35 U.S.C. § 103(a) as being unpatentable over Fukumura in view of Taketoshi, Masa, and Osamu. If this assumption is incorrect, Applicants respectfully request the Examiner provide a non-final Office Action containing a full and complete explanation for the rejection of claims 25 and 29 so Applicants may have an adequate opportunity to properly respond.

Regarding the alternative rejection of claim 25 as being unpatentable over Fukumura in view of Taketoshi, Masa, and Osamu: Osamu fails to cure the deficiencies of Fukumura, and merely teaches a thermistor 1 measuring the environmental temperature and a temperature correcting means 2 which, as best as Applicants can tell, is a mathematical formula (see columns 3 and 4). Osamu, either separately or in any combination with Fukumura, Taketoshi, and Masa, fail to teach or suggest at least "correction processing means for selectively reading, from the first storage means, a corrected temperature corresponding to the ambient temperature detected by the temperature detecting means, and for correcting the operation of electronic circuit on the basis of the corrected temperature and the operation correction data stored in the second storing means" as recited in claim 25. Accordingly, Applicants request the Examiner withdraw the rejection of claim 25. Claim 29 includes recitations similar to claim 25, and is allowable for at least the same reasons as claim 25. Claims 26 and 30, depend from claims 25 and 29, respectively, and are allowable at least by virtue of their respective dependencies from claims 25 and 29.

Applicants respectfully request that this Request for Reconsideration under 37 C.F.R. § 1.116 be considered by the Examiner, placing claims 23-30 in condition for allowance.

Furthermore, Applicants respectfully point out that the final action by the Examiner presented some new arguments as to the application of the art against Applicant's invention. It is respectfully submitted that consideration of this Request would allow the Applicants to reply to the final rejections and place the application in condition for allowance.

In view of the foregoing remarks, Applicants submit that this claimed invention is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicants therefore request the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

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By: E. Niang Reg. No. 52,070
for Richard V. Burgujian
Reg. No. 31,744